

REMARKS

In response to the Office Action mailed May 18, 2005, Applicants respectfully request reconsideration. Claims 1-31 are currently pending in this application. The application as presented is believed to be in condition for allowance.

Rejection Under 35 U.S.C. §101

The Office Action rejected claims 1, 2, 5, 7, 9 and 10 under 35 U.S.C. §101, asserting that the claims are directed to a process and method which can be done manually without any type of technology device. *See* Office Action, page 6, ¶5. Applicants respectfully disagree with this rejection.

However, to further the prosecution of the application, Applicants have amended claim 1 to recite, “[a] method of processing business reply mail *using a sorting apparatus* (emphasis added).” Thus, claim 1, as amended, does not recite a process and method which can be done manually without any type of technology device. Accordingly, it is respectfully requested that the rejection of claim 1 under 35 U.S.C. §101 be withdrawn.

Claims 2, 5, 7, 9, and 10 depend from claim 1, and therefore are also directed to a method of processing business reply mail using a sorting apparatus. Accordingly, it is respectfully requested that the rejection of these claims under 35 U.S.C. §101 be withdrawn.

Rejection Under 35 U.S.C. §102

The Office Action rejected claims 1-10 and 21-31 under 35 U.S.C. §102(b) as purportedly being unpatentable over Connelly (6,459,953). Applicant respectfully traverses this rejection.

Connelly is directed to a business reply mail processing system (Col. 2, lines 65-67). As shown in Figure 5, business reply mail pieces may be fed into the system and scanned to generate an image of the business reply mail piece (Col. 5, lines 6-33). Data may be captured from the image of the business reply mail piece and electronically stored so that the information on the business reply mail piece need not be manually entered (Col. 5, lines 34-47).

Only business reply mail pieces are fed into and processed by the business reply mail processing system of Connelly. That is, the system of Connelly does not receive a general

stream of mail that includes both business reply mail pieces and non-business reply mail pieces. Nowhere does Connelly disclose or suggest that any type of mail other than business reply mail is processed by the business reply mail processing system.

Claim 1

Claim 1 is directed to a method of processing business reply mail using a sorting apparatus, comprising acts of: receiving a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece; automatically identifying the at least one business reply mail piece in the stream of mail pieces; and in response to the act of identifying the at least one business reply mail piece, automatically reading information on the at least one business reply mail piece.

Connelly fails to disclose or suggest, “receiving a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece,” as recited in claim 1. As discussed above, the system of Connelly does not process non-business reply mail pieces. Only business reply mail pieces are fed into the system. Thus, the system of Connelly does not receive a stream of mail pieces that include **at least one non-business reply mail piece**.

The Office Action asserts that Connelly discloses this limitation at Column 1, lines 57-59. The cited portion of Connelly states, “[t]he present invention provides a business reply mail processing system, a method of processing business reply mail and a data structure for use in processing business reply mail. Generally, this is accomplished by organizing information associated with different mail campaigns into respective job sets and using the job data sets to process the business reply mail pieces.” Nowhere does the above-quoted paragraph disclose or suggest that non-business reply mail pieces are processed. Indeed, this paragraph exclusively discusses the processing of business reply mail pieces.

Thus, claim 1 patentably distinguishes over Connelly. Accordingly, it is respectfully requested that the rejection of claim 1 under 35 U.S.C. §102(b) be withdrawn.

Claims 2-9 depend from claim 1 and are patentable for at least the same reasons. Accordingly, it is respectfully requested that the rejection of these claims be withdrawn.

Claim 21

Claim 21 is directed to a sorting apparatus comprising: at least one feeder unit that receives a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece; and at least one controller that: automatically identifies the at least one business reply mail piece in the stream of mail pieces; and in response to identifying the at least one business reply mail piece, automatically reads information on the at least one business reply mail piece.

As should be clear from the discussion above, Connelly does not disclose or suggest a sorting apparatus comprising, “at least one feeder unit that receives a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece,” as recited in claim 21. Rather, the system of Connelly receives a set of mail pieces that includes **only business reply mail pieces and does not process non-business reply mail pieces.**

Thus, claim 21 patentably distinguishes over Connelly. Accordingly, it is respectfully requested that the rejection of claim 21 under 35 U.S.C. §102(b) be withdrawn.

Claims 22-31 depend from claim 21 and are patentable for at least the same reasons. Accordingly, it is respectfully requested that the rejection of these claims be withdrawn.

Rejection Under 35 U.S.C. §103

The Office Action rejected claims 11-16 and 17-20 under 35 U.S.C. §103(a) as purportedly being obvious over Sansone (6,108,643) in view of Connelly. Applicant respectfully traverses this rejection.

Sansone is directed to a system for metering permit mail that has an encrypted message affixed to the mail piece. Sansone discloses that the non-variable information may be pre-printed on a mail piece to produce a postal indicia in a first pass and that variable information may be printed within the postal indicia on the mail piece in a second pass (Col. 4, lines 13-39). Nowhere does Sansone disclose or suggest that business reply mail pieces are processed or that a stream of mail that includes both business reply mail pieces and non-business reply mail pieces is received. Indeed, Sansone does not even mention business reply mail.

Claim 11 is directed to at least one computer readable medium encoded with instructions that, when executed on a computer system perform a method of processing business reply mail,

the method comprising acts of: receiving a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece; automatically identifying the at least one business reply mail piece in the stream of mail pieces; and in response to the act of identifying the at least one business reply mail piece, automatically reading information on the at least one business reply mail piece.

The Office Action asserts that each limitation of claim 11 is disclosed by Sansone alone, without any modification or combination with other references. *See* Office Action, pages 14-15. Thus, it is unclear why claim 11 is rejected under §103 instead of §102. Clarification is respectfully requested. For the purposes of this response, Applicant treats the rejection of claim 11 as a rejection under 35 U.S.C. §102.

Sansone fails to disclose or suggest, “receiving a stream of mail pieces that includes at least one business reply mail piece and at least one non-business reply mail piece,” as recited in claim 11. The Office Action asserts that Sansone discloses this limitation in Figure 3. Figure shows a portion of a metered mail piece. Applicant respectfully disagrees. Simply because a mail piece is metered (i.e., instead of having a stamp) does not mean that the mail piece is business reply mail. There is no disclosure or suggestion in Sansone that the mail piece shown in Figure 3 is a business replay mail piece. Thus, Sansone does not disclose or suggest receiving a stream of mail that includes a business reply mail piece.

Sansone also fails to disclose or suggest, “automatically identifying the at least one business reply mail piece in the stream of mail pieces,” as recited in claim 11. The Office Action asserts that Sansone discloses this limitation via Figure 2, reference number 18. Reference number 18 in Figure 2 merely indicates that the mail piece in Figure 2 is First Class mail. Applicant respectfully disagrees. Sansone does not disclose or suggest that this mail piece is business reply mail or that business reply mail may be automatically identified in a stream of mail pieces that includes both business reply mail pieces and non-business reply mail pieces.

Further, Sansone fails to disclose or suggest, “automatically reading information on the at least one business reply mail piece.” The Office Action asserts that this limitation is disclosed at Figure 2, reference numbers 18, 19, and 20, because these reference numbers identify the class of mail, the name of country, and the post office that issued it. *See* Office Action, page 15, lines 1-4. Applicant respectfully disagrees. As discussed above, Sansone does not disclose or suggest

that the mail piece in Figure 2 is a business reply mail piece. Further, Sansone does not disclose or suggest that information indicated by reference numbers 18, 19, and 20 are automatically read from the mail piece in Figure 2. Nowhere does Sansone disclose or suggest automatically reading information from a business reply mail piece.

For the foregoing reasons, claim 11 patentably distinguishes over Sansone. Accordingly, it is respectfully requested that the rejection of claim 11 under 35 U.S.C. §103(a) be withdrawn.

Claims 12-20 depend from claim 11 and are patentable for at least the same reasons. Accordingly, it is respectfully requested that the rejection of these claims be withdrawn.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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Docket No.: L0562.70049US00
Date: 8/ /05
x08/20/05x